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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,491	03/19/2004	Mary Cismowski	60388-AB-PCT-US	8086
7590	11/26/2004		JPW/GJG/J	
John P. White Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			EXAMINER SULLIVAN, DANIEL M	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/804,491

Applicant(s)

CISMOWSKI ET AL.

Examiner

Daniel M Sullivan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-41 and 52-78 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 30-41 and 52-78 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

The amendment filed 19 March 2004 has been entered. Claims 1-29 and 42-51 were canceled and claims 30, 32, 33, 62-65, 68-71, 74, 76 and 77 were amended therein. Claims 30-41 and 52-78 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 30-41 and 72-78, drawn to a method for identifying a compound that modulates signal transduction in a cell comprising determining the effect of a test compound on the activity of an AGS protein, classified in class 435, subclass 7.1.
- II. Claims 52-54, drawn to a method for detecting the presence of an AGS protein in a biological sample comprising contacting a biological sample with an agent capable of detecting the AGS protein or mRNA, classified in class 435, subclass 6.
- III. Claims 55-71, drawn to a method for identifying a compound that activates a signal transduction pathway in a cell comprising contacting a cell that undergoes a measurable change when the signal transduction pathway is activated and determining if the test compound causes a measurable change, classified in class 435, subclass 29.

The inventions are distinct, each from the other because of the following reasons:

The Inventions listed as Groups I-III are drawn to distinct methods limited to comprising different process steps and directed to different outcomes. The method of Group I requires

Art Unit: 1636

determining the effect of a test compound on the activity of an AGS protein, a process step which is not required in the methods of Groups II and III. The method of Group II is limited to comprising the process step of detecting the presence of an AGS protein in a biological sample, which process step is not required in the methods of Groups I and III. Group III requires determining a measurable change resulting from activation of a signal transduction pathway, which step is not required in the methods of Groups I and II. Furthermore, while the methods of Groups I and II are limited to determining the effect of a test compound on, or detecting the presence of an AGS protein, the scope of the method of Group III extends to identifying a compound that activates any signal transduction pathway, regardless of the status of an AGS protein in a cell.

Search and examination of the methods of Groups I-III together would impose a serious burden on the Office. First, the Inventions of Groups I-III are separately classified, which is *prima facie* evidence of the additional burden imposed by searching both inventions together. Furthermore, as described above, each Group is limited to comprising elements which are not required to practice the other methods as claimed. Therefore, a search of any one method does not adequately cover the scope of the other methods, and a determination that any one method is anticipated by the art does not render the other methods obvious without an additional search. Likewise, given the divergent subject matter embraced by the different Groups, a determination that any one Group is free of the art does not evidence patentability of the other Groups. Therefore, examination of the distinct methods together in a single application would be unduly burdensome.

Art Unit: 1636

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel M Sullivan, Ph.D.
Examiner
Art Unit 1636